

REMARKS

Claims 1-2, 4-10, 12-19 are active. Claims 3, 11 and 20 are canceled. Claims 1, 2, 5, 6, 10, 11 (canceled), 14-18 are rejected under 35 USC 103 as being unpatentable over Hart '509. Claims 4, 7, 8 12, 13 16 and 19 are rejected under 35 USC 103 as being unpatentable over Hart in view of Ahn ,920.

Amended claims 1-2, 4-10, 12-19 are submitted for the Examiner's reconsideration.

Applicants attempted to advance the prosecution of this application by forwarding amended claim 1 for the Examiner's consideration. In telephone interviews with the Examiner and the Examiner's supervisor, regarding the proposed amended claim 1, no agreement was reached. The undersigned was told that prosecution on the merits is closed and that the proposed amendment added new issues. Applicants had originally submitted a proposed claim 1 on April 22, 2008, but this was not accepted in the Advisorys of April 30 and May 13, which repeats the April Advisory on the grounds that new matter was raised as to the issue of the meandering current channel as minimizing parasitic capacitance was not in the disclosure. Also numerous discrepancies were noted in the amended claim indicating the criticality of the amendment to the overlying region was not shown.

These conclusions are in error as misconstruing the claim 1 as amended. The parasitic capacitance refers to the claim as a whole and not merely to the last clause in which it occurs. A fair reading of the specification would make this clear. Claims are construed in light of the specification.

A copy of the MPEP 707 II was submitted also. This states that where the claims and applicants' arguments are such that the claims are intended to be directed to patentable subject matter, but the claims in their present form can not be allowed because of defects in omission of a limitation, the examiner should not stop with a

bare objection or rejection of the claims. The MPEP also authorizes Examiner amendments after a final rejection. The MPEP was clearly not complied with in the instant case exalting form over substance during applicants' prior negotiations.

As a result, applicants resubmitted amended claim 1 to address the Advisory Action criticisms of the prior proposed amended claim 1. The criticality of the limitation in the amended claim is its contribution to the minimizing the parasitic capacitance, which is apparent by a fair reading of applicants' disclosure which was not done contrary to the MPEP.

See applicants' specification page 2, lines 13-20, page 3, lines 9-20 and page 4, lines 18-26, discussing parasitic capacitance as a problem to be solved and the overlying range.

The undersigned proposed an amended claim 1 that is believed to overcome the cited reference rejection over Hart as discussed in the interviews. Applicants asserted that Hart does not show or suggest the limited overlap or the problem overcome as presently being claimed, calling for:

wherein the second electrode layer completely overlies the current channel and overlies a portion of the source or drain electrodes of the first electrode layer, the overlying portion with respect to the source or drain electrodes having a width solely in the range from about 0 to about 20 μ m to thereby minimize parasitic capacitance that otherwise might be present

(The underlined portion was previously at the end of the claim instead of the present location after the term 0 to about 20 μ m in the prior proposed claim of April 22.)

The examiner misconstrued the meaning of the term "to thereby minimize parasitic capacitance" in the prior response. This is a whereby clause that applies to the claim in its entirety and not merely to the last clause as misconstrued by the examiner. The examiner recognized this by complaining that the meandering as contributing to the minimizing the parasitic capacitance was contradictory to the applicants' argument. This whereby clause was always as originally presented

intended to apply to the claim as a whole and, in particular to the overlying portion, as is clear from applicants' argument as to this issue.

As previously argued, Hart does not recognize that limiting the overlap as claimed will minimize parasitic capacitance as claimed. This was argued in the prior proposed amendment of April 22, 2008 and should have been recognized for what was intended. Hart's overlap is many orders of magnitude greater. See applicants' spec. page 4, lines 15-26, discussing this problem. Hart does not recognize the problem with parasitic capacitance or its cause. One of ordinary skill is given no direction or hint by Hart of this problem or the claimed solution. The parasitic capacitance term is a whereby clause that results from the claimed structure, and thus is not a limitation. The term "solely" is the only added term that achieves the desired result of minimizing the parasitic capacitance, which result was always intended by this claim. This range was reasonably always intended to be limited to solely the value claimed. Otherwise the corresponding value claimed and disclosed in the specification is meaningless.

The latest telephone interview regarding the present amended claim 1 rejects the amendment on the grounds it raises a new issue and a new search would have to be conducted. Applicants indicated that the prior search should have been directed to this subject matter, because that is what applicants intended to claim.

The criticality of the limitation that the overlying portion with respect to the source or drain electrodes having a width solely in the range from about 0 to about 20 μ m and having a length in the range of the length of the current channel is, from the argument presented and from the specification, and as in the present proposed amended claim, to thereby minimize parasitic capacitance that otherwise might be present is self evident and plainly asserts the so called criticality which is not required. The limitation speaks for itself in view of the whereby clause which explains

the function of the overlying portion limitation. Applicants' remarks and the specification makes it clear what was intended.

The Action states that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill, citing In re Aller. This conclusion misses the point. The overlap portion has nothing to do with what is workable what ever that may means. The circuit will work regardless the overlap value such as shown by Hart. What is at issue is not a workable range, but the recognition of a problem and its claimed solution. Patentability resides in the recognition of a problem wherein the claim solution to that problem comprises patentable subject matter.

See MPEP 2141.02 III, discovering the source of a problem is part of the "whole" inquiry. Claims must be viewed in their entirety. There must be motivation to do what is claimed. Hart provides no such motivation, MPEP 2143.01. To do what applicants have done is an invitation to experiment, which is proscribed. See In re Antonie where a result effective variable (the claimed overlap range) is not obvious from the cited art, MPEP 2141.02 V, which variable effective value is not noted in the reference or reasons supplied as to what effective result would occur by changing this variable. In re Aller is foreign to the issues involved in the present case. The cited references provide no motivation to the claim 1 structure, but rather teach away, the antithesis of obviousness.

Applicants respectfully request that the examiner reconsider and allow amended claim 1. This subject matter is believed allowable over Hart. There is no support in this reference for the amended claim 1 structure limiting the overlap to the claimed range to minimize parasitic capacitance. If the examiner persists in this rejection, he is respectfully requested to point out with particularity where this structure is disclosed in Hart or any other reference, as applicants can not find such

structure disclosed. The remaining references cited of record are believed equally foreign to amended claim 1. Amended claim 1 is believed allowable over the references cited of record.

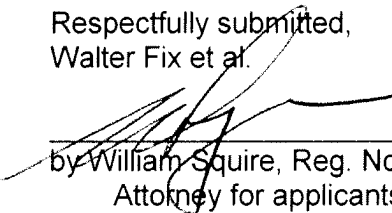
The remaining claims depend from claim 1 and are believed allowable for at least the same reasons.

Applicants respectfully request reconsideration and allowance of this application.

Accompanying this paper is an RCE and a request for a two month extension of time. The Commissioner is authorized to charge deposit account 030678 for any fees due for this paper or credit this account for any overpayments.

Respectfully submitted,
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